

Application No.: 10/022,848

REMARKS

Reexamination and reconsideration of this application is respectfully requested in light of the foregoing proposed amendment and the following remarks.

Claims 1-6, 8-11 and 13-20 are pending in this application. It is proposed to cancel claims 8 and 9 without prejudice or disclaimer and to incorporate the subject matter contained therein into claim 1. Claims 7 and 12 were previously canceled by amendment. These claims were originally dependent on claim 7, which was dependent on claim 1. By the last amendment, the subject matter of claim 7 was incorporated into claim 1. Therefore, the proposed amendment does not introduce new matter or require a new search and consideration since claims 8 and 9 have already been examined. It is respectfully requested that the proposed amendment be entered.

Applicant notes that the previous rejection of the claims as being anticipated by Awatsu et al. (U.S. Patent No. 5,777,304) has been withdrawn and a new ground of rejection over Modi (U.S. Patent No. 6,241,244) has been made.

Rejection

Claims 1-6, 8-11 and 13-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Modi (U.S. Patent No. 6,241,244). Since it is proposed to cancel claims 8 and 9, the rejection as to these claims would be moot. This rejection, however, is improper since the Modi patent is not a prior art under 35 U.S.C. § 102(b). The present application was filed in the United States on December 20, 2001. Therefore, the critical date for a reference to be prior art under 35 U.S.C. § 102(b) is December 20, 2000. The Modi patent was published on June 5, 2001, which is less than one year before the filing date of the present application. Accordingly, the Modi patent does not qualify as prior art under 35 U.S.C. § 102(b). It is respectfully requested that the

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rejection of the claims under 35 U.S.C. § 102(b) be reconsidered and withdrawn. However, to the extent that it may be prior art under 35 U.S.C. § 102(e), the following comments are made.

Applicant's invention is directed to an automated teller machine (ATM) for performing cash transactions. As noted above, it is proposed to amend claim 1 to include the limitations of both claims 8 and 9. Neither of these limitations are not taught nor suggested by Modi. In particular, according to the Examiner, the claimed control unit is taught by description at col. 3, lines 16-67; cols. 4-5; and col. 9, lines 43-64 of Modi. Applicant respectfully disagrees.

Claim 1 recites a control unit that stores operation information which includes (i) information regarding currency in the currency cassettes and (ii) information from the discrimination unit indicating a range of a currency which has been discriminated by the discriminating unit. Using this information, the control unit judges or determines whether the money sort information is within the range of currency indicated by the discrimination information.

The Modi's machine includes a control system 30. Modi describes his control system as follows:

The machine 10 includes a control system generally indicated 30. The control system is in operative connection with the components of the machine and controls the operation thereof in accordance with programmed instructions. Control system 30 also provides communications with other computers concerning transactions conducted at the machine. Such communications may be provided by any suitable means, such as through telephone lines, wireless radio link or through a connection through a proprietary transaction network.

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This description of the control system does not teach or suggest that Modi's control system determines whether the money sort information is within a range of the discrimination information as required by claim 1. Modi merely describes a very general recycling automated banking machine, i.e., identifying inserted paper currency, storing the currency in a storage area (detachable cassette), and withdrawing the stored currency from the ATM machine. Modi's disclosure fails to disclose or suggest the control feature set forth in claim 1, i.e., using the control system to check whether the ATM can dispense the currency requested.

For example, if the operation information indicates that a certain amount of U.S. paper currency (range) is requested, the control unit determines whether the right cassette is being used to dispense currency. If the determination is YES, i.e., the cassette containing the U.S. paper currency is being accessed, the ATM will operate. The control system then checks the range or scope of paper currency discriminated as being U.S. paper currency before it is dispensed. If the determination is NO, because for example, the cassette information indicates Japanese paper currency, the ATM can not operate. In this instance, the unit requires operator assistance.

The Examiner's apparent reliance on Modi's identification device 88 shows a misunderstanding of Applicant's claimed invention. There is no description in Modi's identification device 88 determines whether or not the money sort information of the cassette information of a cassette which is set to the ATM falls within a range or scope of the discrimination information of the operation information. Modi describes his identification device at col. 18, lines 4-21 as follows:

This identification device is suitable for identifying the type and denomination of a passing document. It also is suitable for distinguishing genuine documents from suspect documents. An advantage of the device

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used in the preferred embodiment is its ability to identify a document despite the failure of the document to be in alignment with the sheet path. It should be understood that because of variable conditions, despite efforts made to orient the sheet, sheets may still be somewhat out of alignment at the time of analysis by the identification device. Of course in other embodiments, other devices for identifying sheets may be used.

The analysis of the note by the identification device 88 produces signals. These signals may be indicative of the note type and denomination. Alternatively, the signals may be indicative that the note cannot be satisfactorily identified or are invalid. These signals are transmitted to the control system 30 which operates the divert gates 90 adjacent to the central transport.

There is no disclosure or suggestion that the control unit determines if currency is being drawn from the right cassette.

In addition to not disclosing or suggesting the subject matter of claim 8, Modi also fails to disclose or suggest the subject matter of claim 9, which is proposed to be incorporated into claim 1. The subject matter of claim 9 requires the control unit to cause "noncoincidence" to be displayed on a staff member panel. Col. 9, lines 1-19 of Modi, relied upon by the Examiner, merely describes the customer interface area 14 as shown in Fig. 1. It does not disclose or suggest a staff member display. Also, col. 18, lines 55-66 of Modi relied upon by the Examiner merely describes that unidentifiable sheets are being returned to the customer and that returning of the unidentifiable sheets is displayed to the customer, not to a staff member. In other words, the unidentifiable sheets inputted by the customer in to machine 10 are returned to the customer as a result of the inspection of notes or documents by identification device 88.

The Examiner further maintains that the Examiner's rejections to claim 1 are also applied to claim 14 of the present application. However, claim 14 defines a main body control unit and a control unit of the currency deposit/withdraw mechanism. The claim further recites that the

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operation information of the main body control unit and the cassette information as well as the discriminatable range information of the currency deposit/withdraw mechanism are transmitted to each of the control units. In Modi, the control system 30 is only provided, that is, there is no other control unit corresponding to the control unit of the applicant's deposit/withdraw mechanism. Thus, it is impossible for Modi to disclose or suggest the subject matter of claim 14 in that the operation information and the cassette information as well as discriminatable range information are transmitted between the main body control unit and the control unit of the currency deposit/withdraw mechanism.

As for claim 20, this claim defines a centralized managing system in which the center apparatus collects and manages information indicative of currency range which should be handled by each of ATMs and information indicative of an amount of currencies which are stored in cassettes of the ATMs. Modi's recycling automated banking machines may be coupled to the center apparatus. However, Modi is silent about the management by the center apparatus as recited in claim 20 of the present application. Col. 3, lines 45-67 and col. 4, lines 31-67 of Modi relied upon by the Examiner merely describe the deposit and withdrawal performed by the recycling automated banking machines.

For all of the foregoing reasons, the Office Action does not establish a *prima facie* case of anticipation under 35 U.S.C. § 102(e) of claims 1, 14 and 20 by Modi, including the claims dependent thereon.

Conclusion

It is submitted that the claims 1-6, 10, 11 and 13-20 are patentable over the teachings of the prior art relied upon by the Examiner. Accordingly, favorable reconsideration of the claims

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is requested in light of the proposed amendment and remarks. Allowance of the claims is courteously solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. § 1.17 and due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



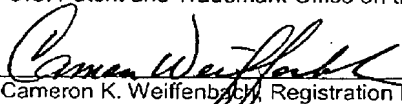
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